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10/571,478

03/10/2006

Joachim Weber

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

GREEN, ANTHONY J

ART UNIT

PAPER NUMBER

1755

MAIL DATE

DELIVERY MODE

05/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/571,478 | Applicant(s) WEBER ET AL. | |
| | Examiner Anthony J. Green | Art Unit 1755 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The preliminary amendment submitted on 10 March 2006 has been entered.
Claims 12-13 were added and accordingly claims 1-13 are currently pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reisacher et al (US Patent No. 6,284,035 B1).

The reference teaches, in the abstract and the claims, pigment preparations in granule form comprising 50 to 99.5% by weight of at least one inorganic pigment and 0.5 to 50% by weight of a least one organic pigment. The preparations are used for coloring polymeric materials such as paints, inks and plastics (see column 3, lines 50+).

The instant claims are obvious over the reference. While the reference does not recite that the organic yellow pigment is the same as instantly claimed it does broadly teach that various organic pigments such as azo pigments etc may be utilized. Accordingly one of ordinary skill in the art would have found it obvious to utilize any type of azo pigment such as those recited in the instant claims without producing any unexpected results absent evidence showing otherwise. As for the amounts of the

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components utilized the amounts recited in claims 6 and 12 are encompassed by the amounts recited by the reference. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Application No. WO 02/055610.

The reference teaches, in the claims, a yellow pigment composition comprising yellow nickel titanate and at least one yellow organic pigment containing a benzimidazolone moiety. The composition may further comprise various other inorganic pigments. The composition may be used to pigment various plastic compositions.

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The instant claims are obvious over the reference. While the reference does not recite that the organic yellow pigment is the same as instantly claimed it does broadly teach that various benzimidazolone pigments may be utilized. Accordingly one of ordinary skill in the art would have found it obvious to utilize any type of benzimidazolone pigments such as those recited in the instant claims without producing any unexpected results absent evidence showing otherwise. As for the amounts of the components utilized the amounts recited in claims 6 and 12 are encompassed by the amounts recited by the reference. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

5. Claims 1, 7-8, 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. JP 2003-232914A.

The reference teaches, in the abstract, and the claims, a color composition comprising at least one kind of yellow pigment selected from the group consisting of C.I. Pigment Yellow 194 and C.I. Pigment Yellow 214, a green pigment and a binder resin. In paragraph [0013] of the machine translation the reference teaches that an organic green pigment is desirable and recites various types.

The instant claims are obvious over the reference. While the reference does not specifically teach that an inorganic pigment is utilized as the green pigment it does broadly teach that various green pigments may be utilized and that an organic pigment is preferred. Based on this teaching it is believed that one may use other types of green pigments such as inorganic ones as the use of an organic green pigment is merely preferred, not required. Accordingly it would have been obvious to utilize other green pigments such as an inorganic green pigment without producing any unexpected results absent evidence showing otherwise. Accordingly the instant claims are rendered obvious by the reference.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to what is meant by the phrase "disazo pigment in the formula (I).

In claim 6 the phrase "the weight ratio" lacks proper antecedent basis.

In claim 9 the phrase "the synthesis steps" (first occurrence) lacks proper antecedent basis. The phrase "the coupling component" (first occurrence) lacks proper antecedent basis.

In claim 10 the term "high" in claim is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 11 the term "high" in claim is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 12 the phrase "the weight ratio" lacks proper antecedent basis.

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Information Disclosure Statement

8. The remaining references have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

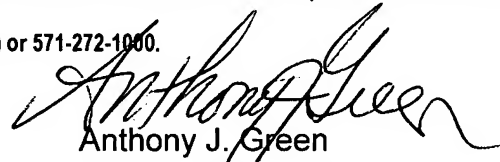
References Cited By The Examiner

9. The remaining references have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
May 17, 2007